

REMARKS

Claims 1-10 are pending. Claims 1, 4, 7 and 8 are independent.

Initially, the Office Action alleged that a sufficient claim to priority under 35 U.S.C. 119(b) has not been filed to support the certified copy of the priority document that is acknowledged to have been received. This is incorrect.

In the first place, the Examiner himself recognizes that the priority documents were referred to in the Declaration and in the Application Data Sheet. In particular, the reference in the Application Data Sheet clearly identified, under the section "Prior Foreign Applications," the Japanese application number of the priority document, its country, its filing date, and the fact that priority is being claimed. 37 C.F.R. 1.76(b)(6) reads: "providing this information in the application data sheet *constitutes the claim for priority* as required by 35 U.S.C. 119(b) and 1.55(a)." (Emphasis supplied). Thus, the required claim to priority has been met by the Application Data Sheet standing alone.

Even though the above-mentioned listing on the Application Data Sheet is sufficient in and of itself to meet the requirement under Section 119, the claim to priority was *also* made quite clearly on the Transmittal letter, which stated: "priority is claimed under 35 U.S.C. 119: convention date: December 22, 2000 for Japan Appln. S.N. 2000-390810."

And of course, the claim to priority was also made on the Combined Declaration/Power of Attorney, filed April 20, 2002 (within four months of filing). Any of these *three* claims to priority would meet the requirement under 35 U.S.C. 119(b). It is requested that the Examiner acknowledge applicant's claim to priority in the next Office Action.

With regard to the Information Disclosure Statement, the Examiner has crossed out the Japanese language references cited in the August 25, 2003 Statement. However, a translation of the relevant portion of the Japanese Office Action in which these references were originally cited was included with the Information Disclosure Statement. This translated portion meets the requirements set forth in the MPEP for the statement of relevance. Accordingly, the references should have been indicated as having been considered. It is requested that the SB/08 form be returned with the next Office Action with all the listed Japanese documents initialed.

Claims 1-10 were rejected under 35 U.S.C. 103 over U.S. Patent 5,310,997 (Roach et al.) in view of U.S. Patent 5,804,807 (Murrah et al.). Applicant traverses and submits that the independent claims are patentable over the cited references for at least the following reasons.

Independent claim 1 is directed to an in-store product information retrieval system having a portable user terminal, a wireless apparatus provided for each product displayed within a store and communicating with the portable user terminal, a store computer provided in the store and a network connecting the wireless apparatus with the store computer.

The system includes: a means for making a request for retrieval of product information from the portable user terminal when the portable user terminal approaches to within a prescribed distance of a wireless apparatus corresponding to a product for which retrieval of product information is desired; a means for sending from the wireless apparatus to the store computer the request received from the portable user terminal by adding an identification number of the wireless apparatus; a database provided in the store computer and storing product information; a retrieval means, provided in the store computer, for performing retrieval of product information stored

in the database based on the identification number of the wireless apparatus received from the wireless apparatus; a sending means, provided in the store computer, for sending retrieval results to the wireless apparatus with the identification number; and a receiving means, provided in the portable user terminal, for receiving retrieval results from the wireless apparatus.

As discussed in the Background section, in prior art systems, even when the customer is provided with a wireless terminal, for example with a bar code reader, such as in JP 05-20548, if the customer wishes to obtain information about a product, it is necessary for the customer to input the product code, for example by using the bar code reader on the product itself.

On the other hand, a salient feature of claim 1 is the provision of a wireless *apparatus provided for each product displayed within a store and communicating with the portable user terminal*. As a result, each product has an associated wireless apparatus that communicates with a customer's portable user terminal. In particular, in claim 1, when the portable user is within a certain distance from the wireless apparatus corresponding to a product, a request for retrieval of product information may be made.

The request is sent by the wireless apparatus associated with a product to a store computer by adding an identification number of the wireless apparatus. The store computer sends the product information to the wireless apparatus, which in turn is received by the portable user terminal.

On the other hand, in Roach, using scanning technology, a membership card is scanned, and a UPC product code label is read by a pen scanner to input the product code information from the product. As will be understood, this scheme suffers from

the same deficiencies as the prior art mentioned in the Background, since the product must be brought to a scanner.

At page 4 of the Office Action, the statement is made that "Roach teaches all of the elements claimed with the exception of utilizing a wireless network as the method of transmitting data throughout the store." This is incorrect. Roach contains no structure that corresponds to the wireless apparatus provided for each product displayed. There is no hard-wired version or analogue of this feature in Roach. In Roach, the products displayed in the store are not provided with *any* corresponding means of communication at all, still less a wireless means.

So it is completely inaccurate to say that Roach teaches everything except wireless connection. In fact, Roach contains no teaching, inter alia, of *any* apparatus, wireless or otherwise, that is (1) provided for each product displayed in the store; and (2) in communication with the portable user terminal.

Nor is there any teaching of the specific recitations of the means for making a request. In fact, there is no corresponding function taught in Roach (in which a product must be brought to a scanner). Roach has no teaching or suggestion of a wireless apparatus corresponding to a product, and no means of performing the function recited in the recited means for making a request.

Based on the incorrect assessment of the deficiencies of Roach, the Office Action took the position that all that would be required to overcome these deficiencies would be a showing in the prior art that wireless technology is generally known, e.g., "to avoid extensive wiring," etc. Office Action at page 4. Murrah et al. is cited as an example.

However, as was discussed above, simply replacing wired connections in Roach with wireless connection would do nothing to cure the deficiencies of Roach as a reference. Roach contains no wired counterpart to at least the wireless *apparatus corresponding to each product displayed in the store*. Moreover, there is no teaching in Roach, or Murrah for that matter, of a request being made when a portable terminal *comes within a prescribed distance of anything*, still less an apparatus corresponding to a displayed product. For at least the foregoing reasons, no prima facie case of obviousness has been established.

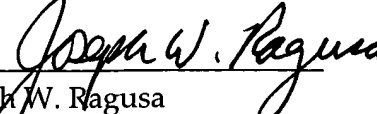
If the rejection is to be maintained, the Examiner is requested to show where each and every limitation of claim 1, particular those mentioned in the foregoing paragraphs, would be found even in a wireless version of Roach. Independent claim 7 recites substantially similar features and is believed patentable for at least the same reasons as claim 1.

Independent claims 4 and 8 each recite, inter alia, a wireless apparatus provided for each product displayed within a store and communicating with a portable user terminal. As mentioned above, even when combined, there is no teaching in Roach or Murrah of any apparatus, *wired or wireless*, that is provided for each product displayed in the store and that is in communication with a portable user terminal. Thus, no prima facie case of obviousness has been established. For at least this reason, independent claims 4 and 8 are believed patentable over the cited art.

The other claims are dependent upon one or another of the independent claims discussed above and are patentable at least for the same reasons. In view of the above, applicant believes the pending application is in condition for allowance.

Dated: July 12, 2006

Respectfully submitted,

By 
Joseph W. Ragusa

Registration No.: 38,586

DICKSTEIN SHAPIRO LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 277-6500

Attorney for Applicant